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| 09/881,360 | 06/13/2001 | Steven E. Norby | 20366-080400 | 8741 |

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| EXAMINER | |
|---|---|
| NG, CHRISTINE Y | |
| **ART UNIT** | **PAPER NUMBER** |
| 2663 | |

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/881,360 | NORBY, STEVEN E. | |
| | Examiner | Art Unit | |
| | Christine Ng | 2663 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *08 August 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-3,5-9,11-18 and 20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-9,11-18 and 20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *13 June 2005* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments, see page 8, line 4 to page 9, line 12, filed August 8, 2005, with respect to the rejection(s) of claim(s) 1, 7 and 13 under 35 USC § 102 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of U.S. Patent No. 6,760,602 to Tangorra et al.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 6-9, 11, 13-15, 17 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,760,602 to Tangorra et al.

Referring to claim 1, Tangorra et al disclose a method for establishing a personal communication between an originating end (Figure 1, mobile station 26) and a terminating end (Figure 1, base station 30,32) of a communication system. Refer to Column 2, lines 43-58. The method comprises steps of:

Retrieving a first plurality of personal communication modes (service options- call type: voice, data or fax) associated with the originating end. The base station 30,32

knows the service options (call type: voice, data or fax) supported by the mobile station 26 in order to select a compatible service option. Refer to Column 3, lines 36-39; Column 5, lines 24-28 and lines 41-60; and Column 8, lines 10-18.

Selecting one of the first plurality of personal communication modes, wherein the selecting step comprises:

Determining (Figure 5, step 130) if a second plurality of personal communication modes (service options- call type: voice, data or fax) associated with the terminating end comprises any personal communication modes compatible with the first plurality of personal communication modes. The base station 30,32 steps through its list of "Base Station Preferred Service Options" (BSPSOs), compares each one with the service options supported by the mobile station, and selects a compatible one. Refer to Column 5, lines 41-64.

Automatically choosing a compatible personal communication mode from the first plurality of personal communication modes and the second plurality of personal communication modes. The base station 30,32 steps through its list of "Base Station Preferred Service Options" (BSPSOs), compares each one with the service options supported by the mobile station, and selects a compatible one. Refer to Column 5, lines 41 to Column 6, line 4.

Indicating the compatible personal communication mode to the terminating end. The base station 30,32 performs the service option toggling procedure of Figures 4-5. Refer to Column 5, lines 41 to Column 6, line 4.

Wherein the compatible personal communication mode uses a communication transport method: facsimile communication (fax) and wireless voice phone communication (voice). Refer to Column 5, lines 24-28 and Column 8, lines 10-18.

Referring to claim 2, Tangorra et al disclose that the method further comprises the steps of:

Receiving the first plurality of personal communication modes (service options- call type: voice, data or fax) from a first user (user of mobile station 26) associated with the originating end (mobile station 26). Refer to Column 4, lines 1-11.

Receiving the second plurality of personal communication modes (service options- call type: voice, data or fax) from a second user (system operators) associated with the terminating end (base station 30,32). Refer to Column 4, lines 11-18.

Referring to claim 3, Tangorra et al disclose that the compatible personal communication mode (service options- call type: voice, data or fax) couples communication between individuals. Refer to the rejection of claim 2.

Referring to claim 6, Tangorra et al disclose that the automatically choosing step is based, at least in part, upon input received from: an originating end (mobile station 26). The base station 30,32 steps through its list of "Base Station Preferred Service Options" (BSPSOs), compares each one with the service options supported by the mobile station, and selects a compatible one. Refer to Column 5, lines 41 to Column 6, line 4.

Referring to claim 7, Tangorra et al disclose a method for automatically selecting a compatible personal communication mode (service options- call type: voice, data or

fax) between an originating end (Figure 1, mobile station 26) and terminating end (Figure 1, base station 30,32) of a communication system. Refer to Column 2, lines 43-58; Column 3, lines 36-39; Column 5, lines 24-28 and lines 41-60; and Column 8, lines 10-18.

Receiving a first plurality of personal communication modes (service options- call type: voice, data or fax) associated with a originating end. The base station 30,32 steps through its list of "Base Station Preferred Service Options" (BSPSOs), compares each one with *the service options supported by the mobile station*, and selects a compatible one. Refer to Column 5, lines 41-64.

Receiving a second plurality of personal communication modes (service options- call type: voice, data or fax) associated with a terminating end. *The base station 30,32 steps through its list of "Base Station Preferred Service Options" (BSPSOs)*, compares each one with the service options supported by the mobile station, and selects a compatible one. Refer to Column 5, lines 41-64.

Initiating a first personal communication between the originating end and terminating end. The "call type (e.g., fax, modem or voice) is maintained the same throughout the service option toggling procedure as that initially requested by the mobile station." (Column 5, lines 25-28).

Selecting (using the service option toggling procedure, Figures 4-5) the compatible personal communication mode based upon the first plurality of personal communication modes and the second plurality of personal communication modes.

Initiating a second personal communication using the compatible personal communication mode (after performing the service option toggling procedure). After the service option toggling procedure, "a call can be toggled from the initially requested service option to a preferred service option..." (Column 3, lines 45-49). Refer to the rejection of claim 1.

Wherein the compatible personal communication mode uses a communication transport method: facsimile communication (fax) and wireless voice phone communication (voice). Refer to Column 5, lines 24-28 and Column 8, lines 10-18.

Referring to claim 8, Tangorra et al disclose the method further comprises the step of determining that a first personal communication mode for the first personal communication is unavailable. After the service option toggling procedure, "a call can be toggled from the initially requested service option to a preferred service option..." (Column 3, lines 45-49). The preferred service option provides "improved efficiencies for overall system operations and improved customer satisfaction" (Column 6, lines 24-26), since the initially requested service option is not as efficient (unavailable).

Referring to claim 9, Tangorra et al disclose that the selecting step comprises steps of negotiating the compatible personal communication mode with a first decision tree (list of supported service options) associated with the originating end (mobile station 26) and a second decision tree (list of BSPSOs) associated with the terminating end (base station 30,32). The base station 30,32 steps through its list of "Base Station Preferred Service Options" (BSPSOs), compares each one with the service options

supported by the mobile station, and selects a compatible one. Refer to Column 5, lines 41-64.

Referring to claim 11, refer to the rejection of claim 3.

Referring to claim 13, Tangorra et al disclose a personal communication system for establishing personal communication between a originating end (mobile station 26) and a terminating end (base station 30,32). Refer to Column 2, lines 43-58. The personal communication system comprises:

A first plurality of personal communication modes (service options- call type: voice, data or fax) associated with the originating end. The base station 30,32 steps through its list of "Base Station Preferred Service Options" (BSPSOs), compares each one with *the service options supported by the mobile station*, and selects a compatible one. Refer to Column 5, lines 41-64.

A second plurality of personal communication modes (service options- call type: voice, data, fax) associated with the terminating end. *The base station 30,32 steps through its list of "Base Station Preferred Service Options" (BSPSOs)*, compares each one with the service options supported by the mobile station, and selects a compatible one. Refer to Column 5, lines 41-64.

A first personal communication mode that couples the originating end and the terminating end together. The "call type (e.g., fax, modem or voice) is maintained the same throughout the service option toggling procedure as that initially requested by the mobile station" (Column 5, lines 25-28).

A decision mechanism (service option toggling procedure, Figures 4-5) for automatically choosing a second personal communication mode that is compatible with at least one of mode in each of the first plurality of personal communication modes and the second plurality of personal communication modes. After the service option toggling procedure, "a call can be toggled from the initially requested service option to a preferred service option..." (Column 3, lines 45-49). Refer to the rejection of claims 1 and 7.

Wherein the compatible personal communication mode uses a communication transport method: facsimile communication (fax) and wireless voice phone communication (voice). Refer to Column 5, lines 24-28 and Column 8, lines 10-18.

Referring to claim 14, refer to the rejection of claim 8.

Referring to claim 15, Tangorra et al disclose that the decision mechanism is in the terminating end. The base station 30,32 performs the service option toggling procedure of Figures 4-5. Refer to Column 5, lines 41 to Column 6, line 4.

Referring to claim 17, Tangorra et al disclose that the first plurality of personal communication modes (service options- call type: voice, data or fax) is sent from originating end (mobile station 26) to the terminating end (base station 30,32) using the first personal communication mode. The "call type (e.g., fax, modem or voice) is maintained the same throughout the service option toggling procedure as that initially requested by the mobile station" (Column 5, lines 25-28).

Referring to claim 18, Tangorra et al disclose that that the second personal

communication mode is different from the first personal communication mode. After the service option toggling procedure, "a call can be toggled from the initially requested service option to a preferred service option..." (Column 3, lines 45-49), the initially request service option being different from the newly preferred service option.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 5, 12 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,760,602 to Tangorra et al.

Tangorra et al disclose that the first plurality of compatible personal communication modes are stored in a database that is one of: remote to the originating end, remote to the terminating end, proximate to the originating end, and proximate to the terminating end.

However, Tangorra et al disclose in Figure 1 that communication modes (service options- call type: voice, data or fax) supported by the base station 30,32 are stored in a database 35 inside the base station 30,32 (proximate to the terminating end). Refer to Column 5, line 52 to Column 6, line 4. Since the base station holds its supported communication modes in a database 35, it would be an obvious modification to have the mobile station also hold its supported communication modes in a database. Therefore, it would have obvious to one of ordinary skill in the art at the time the invention was

made to include that the first plurality of compatible personal communication modes (call types supported by the mobile station 26) are stored in a database that is proximate to the originating end; the motivation being that the base station also has its compatible personal communication modes stored in an internal database 35.

6. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,760,602 to Tangorra et al in view of U.S. Publication No. 2002/0018487 to Chen et al.

Tangorra et al do not disclose a query menu presented to a user associated with the originating end, wherein presentment of the query menu is performed in response to the first communication mode being unavailable.

Chen et al discloses in Figure 2 a mobile station 205 that includes an application programming interface API 210 that allows "a programmer to change the communication protocol used by an apparatus by selecting an option in a simple menu of options" (Section 0017) in order to "provide timely and efficient adaptation to meet the ever-changing needs of the wireless communication field" (Section 0009). Refer to Section 0040. Although Chen et al do not state that the menu is presented when the first communication mode becomes unavailable, this would allows the user to experience uninterrupted service by immediately switching to a functional mode. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a query menu presented to a user associated with the originating end, wherein presentment of the query menu is performed in response to the first communication mode being unavailable, the motivation being so that the wireless

system can be more flexible and adaptable by accommodating a variety of communication protocols each with its own unique system requirements and allowing the mobile station to be used in different environments as it moves from one location to another. Refer to Sections 0003-0011.

***Conclusion***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine Ng whose telephone number is (571) 272-3124. The examiner can normally be reached on M-F; 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Ngo can be reached on (571) 272-3139. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

C. Ng CN
October 19, 2005

RICKY NGO
PRIMARY EXAMINER
10/27/05